

### ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

In the specification, the Examiner objected to the title. A new title has been provided as suggested by the Examiner

Claims 1-4 remain in this application. The claims have been amended for editorial purposes only. New claim 5 is added without adding any new matter. New claim 5 is based on originally filed claims 1 and 4 with editorial changes, and thus should be allowable as indicated by the Examiner.

The Examiner has not indicated whether the drawings are accepted.

The Examiner objects to the Abstract because it is not drawn to the claimed invention, i.e., a method. The objection is respectfully traversed. The Examiner lists a number of criteria for the content of the Abstract, none of which requires that the abstract be directed toward the claimed invention. Furthermore, the Abstract does contain method description that is consistent with the claimed material. However, an amended Abstract has been provided that removes the purported merits of the invention.

Claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Amai *et al.* (U.S. 4,951,383) in view of Sato *et al.* (U.S. 5,839,187). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a step of "picking up an image of the electronic parts in wafer shape by advancing an image pickup means to above a wafer hold section for holding the electronic parts, wherein the image pick up means is disposed in a manner that the image pick up means can advance to and retreat from the wafer hold section". The Examiner cites col. 14, lines 57-64

of Amao as teaching this step of the claim. However, a close reading of that section does not support the Examiner's argument.

Nowhere in the cited section is an image pickup means described as being disposed in a manner that it can "advance to and retreat from the wafer hold section" as recited in the claim. In fact, the cited section does not describe any image pickup means operation at all, but instead appears to be discussing the operation of nozzle rotation correcting stations. Furthermore, a review of Amao and Sato did not show any teaching of the cited feature of the image pickup means. Accordingly, claim 1 is patentable over the references.

Claim 1 also recites the step of "detecting positions of the electronic parts based on the image of the electronic parts". The Examiner cites col. 15, lines 21-27 of Amao as teaching this step. However, the cited section does not discuss any use of an image of electronic parts. Instead, the section appears to discuss an "original point locating station" for adjusting a "removing nozzle". Such a teaching is not relevant to the cited step. Furthermore, a review of Amao and Sato did not show any teaching of the cited step, and thus claim 1 is patentable over the references for this reason as well.

Furthermore, claim 1 recites that the step of "mounting the electronic parts is performed concurrently with the step of picking up an image of the electronic parts to be next taken out". The Examiner admits that Amao does not teach such a feature, but instead cites Sato as teaching this feature. However a review of the Sato reference does not support the Examiner's argument.

The Examiner cites col. 6, lines 13-41 of the reference as teaching the cited step, but this section of the reference, although listing 11 steps, does not disclose that flip chip bump mounting step 11 is concurrent with camera scan step 3 or the position correction step 4 being performed on parts next to be taken out. In fact, the reference appears to be silent as to the temporal relationship between these steps, except that the reference teaches that "[d]uring step 10, the next flip chip P is subjected to the operations of the steps 6 and 7" (col. 6, lines 36-39). However, it is noted that none of these steps include any mounting or

image pickup steps. Thus, the reference does not teach the cited feature, and thus claim 1 is patentable over the combination of references.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner has merely listed a benefit of the combination, without any argument as to why one skilled in the art would make such a combination absent the teaching of the current application.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34915US1.

Respectfully submitted,

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